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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,498	01/09/2006	Xu Zhang	514572000600	7048

25225 7590 03/19/2007
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
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SAN DIEGO, CA 92130-2040

EXAMINER

SNYDER, STUART

ART UNIT	PAPER NUMBER
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1648

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/538,498	Applicant(s) ZHANG ET AL.	
	Examiner Stuart W. Snyder	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-41, drawn to a method for isolating a target cell, cellular organelle or virus from a sample comprising contacting the sample with a magnetic microbead, allowing the desired product to bind to the microbead, and separating the product-microbead conjugate from other constituents of the sample; said microbead does not contain a product-specific binding moiety.

Group II, claims 42-43, drawn to a kit for practicing the method of Group I.

Group III, claim(s) 44-54, drawn to a method for isolating a target cell or virus from a sample comprising separating the target cell from the virus, contacting the sample with a magnetic microbead, allowing the desired product to bind to the microbead, and separating the product-microbead conjugate from other constituents of the sample; said microbead does not contain a product-specific binding moiety.

Group IV, claim 55, drawn to a kit for practicing the method of Group III.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature of each claimed invention is the absence of specific binding moiety on the bead. However, Bidawid, et al. teaches non-specific binding of Hepatitis virus Type A (HAV) to magnetic beads not coated with HAV-specific binding moieties (see especially Table 1, p181).

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Product to be isolated; origin of sample; nature of magnetizable substance; diameter of microbead; presence and/or nature of microbead modification; additional steps following separation of product from undesired contaminants; manual or automated nature of the method; time of procedure; nature of vessel in which method is practiced; presence or absence of precipitating, poisonous reagents, salts or detergents; temperature at which the method is practiced; pH range in which method is practiced; ion concentration in which method is practiced; presence or absence and/or nature of anticoagulants; freshness of sample; presence or absence of instructions with kits.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

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Product to be isolated (claims 1, 3, 18-19, 27, 35, 42-44, 50, 55); origin of sample (claims 2, 16-17, 27, 29, 34, 36, 45-46, 50); nature of magnetizable substance (claims 5-9); diameter of microbead (claim 10); presence and/or nature of microbead modification (claims 11-12); additional steps following separation of product from undesired contaminants (13-15, 18-20, 31-33, 38-41, 51-52); manual or automated nature of the method (claim 21); time of procedure (claim 22); nature of vessel in which method is practiced (claim 23); presence or absence and/or nature of precipitating, poisonous reagents, salts or detergents (claims 24-25, 29-30, 32, 39, 41, 47-49, and 52); temperature at which the method is practiced (claim 26); pH range in which method is practiced (claim 29, 32, 37, 39, 41, and 52); ion concentration in which method is practiced (claims 29, 32, 39, 47 and 52); freshness of sample (claims 28-33, 36 and 48); presence or absence of instructions with kits (claims 43 and 55).

The following claim(s) are generic: All of the claims are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The common technical feature of each claimed invention is the absence of specific binding moiety on the bead. However, Bidawid, et al. teaches non-specific binding of Hepatitis virus Type A (HAV) to magnetic beads not coated with HAV-specific binding moieties (see especially Table 1, p181).

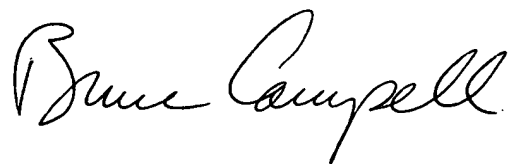
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart W. Snyder whose telephone number is (571) 272-9945. The examiner can normally be reached on 9:00 AM-5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce R. Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stuart W Snyder
Examiner
Art Unit 1648

SWS

A handwritten signature in cursive script, reading "Bruce Campell".

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600